



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,295	03/16/2001	John EN Morten	P 277177	8239

7590 07/02/2002
Pillsbury Winthrop
1600 Tysons Boulevard
McLean, VA 22102

EXAMINER

MYERS, CARLA J

ART UNIT	PAPER NUMBER
----------	--------------

1634

DATE MAILED: 07/02/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,295

Applicant(s)

MORTEN, JOHN EN

Examiner

Carla Myers

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1634

RESTRICTION

Restriction to one of the following inventions is required under 35 U.S.C. § 121 and 372:

- I. Claims 1-5, 7 and 8, drawn to nucleic acids and methods of detecting nucleic acids.
- II. Claim 6, drawn to a computer readable medium.
- III. Claim 9, drawn to a protein.
- IV. Claim 10, drawn to use of an antagonist.
- V. Claim 11, drawn to methods of identifying a compound that modifies expression.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons:

The special technical feature of invention I is considered to be nucleic acids, whereas the special technical feature of invention II is considered to be a computer readable medium and the special technical feature of invention III is considered to be a protein. Inventions I, II and III are drawn to patentable distinct compounds that have different functions and different functional properties. The nucleic acids of invention I are composed of nucleotides linked by phosphodiester bonds, whereas the computer readable mediums of invention II are composed of data and comprise computer hardware and software for manipulating sequence data digitally. Furthermore, the compositions are utilized in different methodologies, such that the nucleic acids of invention I may be used in hybridization assays or in methods for synthesizing proteins, while the computer readable mediums of invention II can be used in a storage capacity or may be

Art Unit: 1634

utilized in methods for searching a databank. Further, the proteins are composed of amino acids arranged in a specific 3-dimensional structure and are useful in methods for generating antibodies or for therapeutic purposes.

It is noted that under 37 CFR 1.475(d) Applicant is entitled to an examination of the first product, method of making said product and method of using said product. In the instant Application, the methods of groups IV and V constitute additional and distinct methods. Furthermore, the methods of inventions IV and V do not specifically require the products of invention I. Accordingly, restriction of groups I-V is proper.

Election Requirement Applicable to Groups 1, 2, 4 and 5

In addition, inventions 1, 2, 4 and 5 detailed above reads on patentably distinct inventions drawn to nucleic acids and proteins comprising distinct polymorphisms. The nucleic acid and protein sequences comprising the polymorphisms are patentably distinct because they are structurally and functionally distinct from one another and a further restriction is applied to each invention.

In response to the restriction requirement, Applicant must further elect a single polymorphism.

It is noted that nucleotide and protein sequences comprising different polymorphisms are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to constitute independent and distinct inventions within the meaning of 35 U.S.C. 121 and 372. Absent evidence to the contrary, each such nucleotide sequence is presumed to

Art Unit: 1634

represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.14.

Because these inventions are distinct for the reasons given above and have acquired a different status in the art as demonstrated by their divergent subject matter and because inventions I-V require different keyword and sequence searches that are not co-extensive, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A telephone call was made to Donald Bird on June 18, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carla Myers whose telephone number is (703) 308-2199. The examiner can normally be reached on Monday-Thursday from 6:30 AM-5:00 PM.

Application/Control Number: 09/787,295

Page 5


Art Unit: 1634

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703)-308-1152. The fax number for the Technology Center is (703)-305-3014 or (703)-305-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Carla Myers

July 1, 2002


CARLA J. MYERS
PRIMARY EXAMINER